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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/682,412  | 10/10/2003  | Eugenie Charriere    | 1004900-000254      | 3439             |
| 21839 7590 06/06/2008<br>BUCHANAN, INGERSOLL & ROONEY PC<br>POST OFFICE BOX 1404<br>ALEXANDRIA, VA 22313-1404 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| SERGENT, RADON A  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1796  |             |                      |                     |                  |
| NOTIFICATION DATE   |             | DELIVERY MODE        |                     |                  |
| 06/06/2008  |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/682,412

**Applicant(s)**

CHARRIERE ET AL.

**Examiner**

Rabon Sergeant

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-51 is/are pending in the application.
- 4a) Of the above claim(s) 50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-49 is/are allowed.
- 6) ☒ Claim(s) 39-43 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/485,533.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Claim 50, as amended within the response of February 28, 2008, is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Previously, applicants claims have required the presence of trimer groups, in the form of isocyanurate or biuret groups, and dimer groups. Furthermore, the previous version of claim 50 specified a dimer containing a trimer group (isocyanurate); therefore, the previous version of claim 50 encompassed the concept of the presence of both dimer and trimer groups. However, current claim 50 no longer sets forth the concept of both trimer and dimer groups being present; therefore, claim 50, as amended, is distinct from the claims as previously set forth and examined.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 50 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 39-43, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

With respect to claims 39-43, the omitted steps pertain to how the claimed biuret unit is obtained absent a step of producing the biuret trimer reaction product. Applicants have argued that the step that recites the (cyclo)trimerization catalyst in the claims provides for producing the biuret trimer reaction product. In response, the argued step specifically states that an *isocyanurate* trimer reaction product is produced, and the position is taken that an isocyanurate structure is distinct from a biuret structure. Accordingly, the position is maintained that there is no recited step that allows for the production of the biuret. Applicants have referred the

examiner to page 18, lines 25-37 of the specification; however, it is not seen that this citation clarifies the issue. Applicants' remarks fail to address the aforementioned fact that the claims only specifically recite the production of isocyanurates.

With respect to claim 51, the omitted steps pertain to how to obtain the claimed isocyanurate units or biuret units. Applicants' claimed step of reacting the isocyanate monomers with a compound comprising at least one function other than isocyanate function fails to allow for or provide for the production of the claimed isocyanurate or biuret groups. Applicants have argued that claim 51 contains a step of reacting in the presence of a (cyclo)trimerization catalyst; however, this is incorrect. Claim 51 contains no such step; therefore, applicants' response is not commensurate with the claim.

3. Claim 51 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to provide adequate written description for the production of isocyanurate groups or biuret groups by simply reacting an isocyanate monomer with a compound comprising a function other than an isocyanate function. It is not seen that applicants' remarks address the examiner's concerns that support has not been provided for producing trimer groups by simply reacting an isocyanate monomer with an isocyanate reactive compound.

4. Claims 44-49 are allowed.

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

R. Sergent  
June 3, 2008